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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,365	06/17/2008	James Bain	BAI-01/SYN.3282.US	3199
23508 7590 07/15/2009 LUNDEEN & LUNDEEN, PLLC PO BOX 131144 HOUSTON, TX 77219-1144			EXAMINER WRIGHT, GIOVANNA COLLINS	
			ART UNIT 3672	PAPER NUMBER
			NOTIFICATION DATE 07/15/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/598,365	Applicant(s) BAIN, JAMES	
	Examiner GIOVANNA C. WRIGHT	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

1. The disclosure is objected to because of the following informalities: The section headings have been omitted.

Appropriate correction is required.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining

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compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 26a-f. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 15-16, 18-19, 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wardley 20020189863.

Referring to claim 15, Wardley discloses (see fig. 1) a shoe for use on the end of a work string within a well bore, the shoe comprising a generally cylindrical body having a first end (at 3) adapted for connection to the work string and a second end (at 5) including a nose portion; the nose portion including a rounded head distal to the body for advancement through the well bore and a plurality of blades (4) extending from the head towards the body; the body having thereupon a reaming portion (8) located behind the nose portion wherein the reaming portion comprises a plurality of discrete raised members to ream the bore.

Referring to claim 16, Wardley discloses the blades (4) include a cutting surface (at 6) to assist in breaking through bridges.

Referring to claim 18, Wardley discloses wherein the raised members (8) are elongate and continuous.

Referring to claim 22, Wardley discloses wherein the nose portion (5) includes one or more ports (7).

Referring to claim 23, Wardley discloses a gauge portion (at 9) located furthest from the nose portion.

Referring to claims 24-26, Wardley discloses the gauge portion comprises a plurality of elongate blades (9) arranged helically along the body.

Referring to claim 27, Wardley discloses the shoe is constructed from a combination of relatively hard and relatively soft materials (paragraph 0050).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 7-14, 17, 19 -21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wardley '863 in view of Mabry 6808019.

Referring to claims 1,3-5, 8,17,19 -21 Wardley discloses (see fig. 1) a shoe for use on the end of a work string within a well bore, the shoe comprising a generally cylindrical body having a first end (at 3) adapted for connection to the work string and a second end (at 5) including a nose portion; the nose portion including a rounded head distal to the body for advancement through the well bore and a plurality of blades (4) extending from the head towards the body; the body having thereupon a reaming portion (8) located behind the nose portion wherein the reaming portion comprises a plurality raised members to ream the bore. Wardley does not disclose the members are mounted oppositely. Mabry teaches (see figs. 3-4) tear drop shaped raised members (26,28) each pair of raised members being mounted oppositely, in parallel and longitudinally along the body, wherein each adjacent pair of members provides a funnel comprising diverging edges of adjacent members and a channel that converges from one end to another. Mabry teaches the shape and mounting of the raised members helps to improve the flow (see col. 7, lines 16-25). As it would be

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advantageous to improve the flow around the reamer, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the reaming members disclosed by Wardley to be teardrop shaped and each pair mounted oppositely in view of the teachings of Mabry.

Referring to claim 2, Wardley discloses wherein the raised members (8) are elongate and continuous.

Referring to claim 7, Wardley discloses wherein the nose portion (5) includes one or more ports (7).

Referring to claim 9, Wardley discloses the blades (4) include a cutting surface (at 6) to assist in breaking through bridges.

Referring to claim 10, Wardley discloses a gauge portion (at 9) located furthest from the nose portion.

Referring to claims 11-13, Wardley discloses the gauge portion comprises a plurality of elongate blades (9) arranged helically along the body.

Referring to claim 14, Wardley discloses the shoe is constructed from a combination of relatively hard and relatively soft materials (paragraph 0050).

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wardley '863 in view of Mabry 6808019 as applied to claim 1 above, and further in view of Herrera 20030106719.

Referring to claim 6, Wardley does not disclose the nose portion is eccentric. Herrera teaches that a nose portion on a shoe can be eccentric to facilitate progress of the casing past obstruction in the bore (paragraph 0003).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIOVANNA C. WRIGHT whose telephone number is (571)272-7027. The examiner can normally be reached on 7:30-4 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Giovanna C. Wright/
Primary Examiner, Art Unit 3672

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